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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,985	12/30/2003	David B. Olson	59460US002	6610
32692	7590	07/20/2006		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER

1713

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/747,985	<b>Applicant(s)</b> OLSON ET AL.	
	<b>Examiner</b> Michael Bernshteyn	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,13-20,26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/09/2006</u>  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action follows a responses filed on May 1 and May 11, 2006. Applicants have amended claims 13 and 26, claim 30 has been added, claims 3-4 and 7-12 have been cancelled to obviate a double patenting rejection with respect to claims 1-12 of copending U. S. Patent Application 10/167,953. Claims 21-25 and 27-29 have been withdrawn.
2. In view of the amendment, the double patenting rejection has been withdrawn. Applicant's arguments with respect to claims 13, 26 and 30 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1, 2, 5, 6, 13-30 are pending.

#### ***Claim Rejections - 35 USC § 102***

4. The test of this section of Title 35, U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 1, 2, 5, 6, 13-20 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson et al. (U.S. Patent 6,261,700), for the rationale recited in paragraph 5 of Office Action dated on February 6, 2006, and comments below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (U.S. Patent 6,261,700) in view of Williams et al. (U.S. Patent 5,855,983).

The disclosure of Olson reference resided in § 5 of Office Action dated on February 6, 2006 is incorporated therein by reference.

Olson does not disclose that a brightness enhancing film comprises an optical layer comprising a linear array of regular right prisms comprising the reaction product.

Williams discloses a flame resistant composite film includes the first layer and the second layer that are joined together. The first layer has a light transmission of at least 93% and is substantially constructed from a radiation-cured polymer and a flame retardant material. The second layer is constructed from thermoplastic polymer resin (abstract).

With regard to the limitations of instant claim 30, Williams discloses that the brightness enhancement film 11 includes an array of prisms typified by prisms 22, 24, 26, and 28, as illustrated in FIG. 2. Each prism, for example, such as prism 22, has a first facet 30 and a second facet 32. The prisms 22, 24, 26, and 28 are formed on a body portion 34 that has a first surface 36 on which the prisms are formed and a second surface 38 that is substantially flat or planar and opposite the first surface. **A linear array of regular right prisms is preferred for both optical performance and ease of manufacture** (col. 2, lines 49-59).

Both references are analogous art because they are from the same field of endeavor concerning new brightness enhancement film.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate optical layer having a linear array of regular right prisms as taught by Williams in Olson's polymerizable composition for optical articles because a linear array of regular right prisms is preferred for both optical performance and ease of manufacture (US'983, col. 2, lines 50-52), and thus to arrive at the subject matter of instant claim 30.

***Response to Arguments***

7. Applicants traverse the rejection under 35 U.S.C. § 102(b) of claims 13-25 and 30 as being anticipated by Olson et al. Applicant's arguments have been fully considered but they are not persuasive.

8. Applicants contend that Olson et al. does not expressly teach brightness enhancing films. Since Olson et al. alone fails to teach all the claim limitations, a rejection under § 102(b) is improper (page 7, 5<sup>th</sup> paragraph).

9. It is noted that with regard to a brightness enhancing films instantly claimed in claims 13 and 26, Olson is silent about it. However, in view of substantially identical composition between Olson and instant claims, it is the examiner position that Mallya's composition inherently possesses this property. It is noted that the claiming of new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

10. Applicants contend that Olson et al. does not teach the particular polymerizable set forth in the independent claims, i.e. a resin composition comprising at least 60 wt-% of one or more of recited first monomers in combination with a crosslinking agent comprising at least three (meth)acrylate functional groups (page 7, the last paragraph).

11. It is noted that Olson clearly discloses that while amounts outside of the following ranges may be useful, preferred binder precursors can include from **about 20 to about 80 parts by weight** (pbw) polymerizable **brominated** compound, e.g., aromatic, brominated (meth)acrylate compound, which is **within the claimed range** (col. 13, lines

19-22). This compound is readable as compound i) in instant claim 13 and as compound a) in instant claim 26.

Olson also clearly discloses the preferred multifunctional non-brominated compounds comprise ester (meth)acrylate compounds such as difunctional (meth)acrylate esters of a polyhydric alcohol, and combinations thereof. Of these, trifunctional and tetrafunctional esters of (meth)acrylate esters of polyhydric alcohol can be especially preferred. Examples of suitable multifunctional ester (meth)acrylates include poly(meth)acrylic acid esters of polyhydric alcohols including, for example, **tri(meth)acrylic acid esters of pentaerythritol**, etc. Particularly preferred multifunctional ester (meth)acrylic acids can comprise a mixture of di-, tri-, and tetra(meth)acrylate esters of **pentaerythritol** (col. 12, line 39 through col. 13, line 13). **Pentaerythritol tri(meth)acrylate** is readable as component b) in the instant claims 13 and 26.

12. In the light of the discussion above, the rejection of record has not been withdrawn. The rejection remains in force.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**

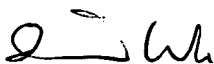
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn  
Examiner  
Art Unit 1713

MB  
07/15/2006

  
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